REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed February 22, 2008. In the Office Action, the Examiner notes that claims 1-25 are pending and rejected. The Applicant herein amends claims 1, 8, 22 and 23. Support for the amendments may be found in the Applicants specification on at least page 36, lines 1-6.

In view of the foregoing amendments and the following discussion, Applicant submits that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicant believes that all of the claims are now in allowable form.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response including amendments.

35 U.S.C. §103 Rejection of Claims 1-7

The Examiner has rejected claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Goldstein U.S. Patent 5,410,326 (hereinafter "Goldstein") in view of Seth-Smith et al. U.S. Patent 4,890,321 (hereinafter "Seth-Smith") and Graczyk et al. U.S. Patent 5,192,999 (hereinafter "Graczyk"). Applicant respectfully traverses the rejection.

Claim 1 recites:

> 1. A set top terminal for generating an interactive electronic program guide for display on a television connected thereto, the terminal comprising:
>
> means for retrieving information about a subscriber;
>
> means for receiving a television signal;
>
> means for extracting individual programs from the television signal;
>
> means to demultiplex video, graphics and text;
>
> means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being

displayed and the audio is accessed remotely from said set top terminal;

means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising a plurality of menus including:

a home menu;

a plurality of major menus displayed as menu options on the home menu;

a plurality of sub-menus displayed as menu options on the plurality of major menus; and

a plurality of during programming menus enacted after selection of a program,

wherein at least one of the plurality of menus comprises the demultiplexed video, graphics and text, and wherein at least one of the plurality of major menus comprises displaying a plurality of audio choices for accessing the audio; and

means for receiving the selection signals from a user input. (emphasis added).

In an exemplary embodiment of the present invention Applicant's invention provides a means such that a subscriber may separately access digital radio channels while other programming is being viewed on the television. (See e.g., Applicant's specification, p. 36, ll. 1-6.) A level D upgrade module may be used in conjunction with a set top terminal to provide the above features. (See *Id.*). Moreover, the digital radio channels may be accessed in a separate room from that of the television. (See *Id.*).

Applicant respectfully submits that Goldstein, Seth-Smith and Graczyk, alone or in any permissible combination, fail to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal, as positively recited by Applicant's independent claim 1.

Goldstein discloses a "universal remote control device which is programmed to operate a variety of consumer products" (Abstract). Goldstein is silent to a feature of a set top terminal having a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed

simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal.

Moreover, Seth-Smith and Graczyk fail to bridge the substantial gap left by Goldstein. The Examiner responds to the Applicant's previous arguments asserting that there is no indication in Seth-Smith that the system would be limited to only one or the other as the Applicant suggests. The Applicant respectfully disagrees.

Seth-Smith teaches that two types of audio may be sent in the horizontal or vertical blanking intervals. One type of audio is the audio associated with the video and a second type of audio is a subscription audio. (See Seth-Smith, col. 7, ll. 58-68). The audio associated with the video clearly is not independent from the television signal.

The second type of audio is the subscription audio. Seth-Smith teaches that if the pay-per-listen bit is on, this means that a set of the audio channels are pay-per-listen channels. (See Seth-Smith, col. 27, ll. 54-57, emphasis added). In other words, the viewer must tune to a channel carrying the subscription audio. Moreover, Seth-Smith does not teach or suggest any picture in picture or multiple tuner embodiments that would allow a user to access two channels simultaneously.

In addition, as the Examiner states "Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output." (See Office Action dated February 22, 2008, p. 3, ll. 15-16, emphasis added). Thus, the Applicant respectfully submits that Seth-Smith is silent as to teaching or suggesting that the subscription audio is accessed simultaneously with the video since Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output.

Regardless, the Applicant further clarifies the claim to specify that the audio is accessed remotely from the set top terminal. This limitations is also absent from Seth-Smith as Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output.

In addition, Graczyk also fails to bridge the gap left by Goldstein and Seth-Smith because Graczyk also fails to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and

the audio is accessed remotely from said set top terminal. Graczyk simply teaches a multipurpose computerized television. (See Graczyk, Abstract).

Consequently, even if Goldstein, Seth-Smith and Graczyk were permissibly combined, the combination would still fail to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal. As such, claim 1 is patentable over Goldstein in view of Seth-Smith and Graczyk under 35 U.S.C. §103(a).

Furthermore, claims 2-7 depend, directly or indirectly, from independent claim 1, while adding additional elements. Therefore, claims 2-7 are also patentable over Goldstein in view of Seth-Smith and Graczyk under §103 for at least the same reasons that claim 1 is patentable over Goldstein in view of Seth-Smith and Graczyk under §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 22 and 23

The Examiner has rejected claims 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Banker et al. (U.S. Patent 5,477,262, hereinafter "Banker") in view of Seth-Smith and Graczyk.

Claim 22 recites:

> 22. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:
>
> means for retrieving information about a subscriber;
>
> means for receiving a television signal;
>
> means for extracting individual programs from the television signal;
>
> means to demultiplex video, graphics and text;
>
> means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal;
>
> means for generating an electronic program guide for controlling

display of content on a television screen, the guide comprising a plurality of menus including:

a plurality of interactive menus, each corresponding to a level of interactivity and having one or more interactive menu items for selection; and

a main menu having one or more main menu items for selection, which main menu items correspond to the interactive menus, wherein the menus are navigated using a user input, and wherein the main menu items and the interactive menu items are responsive to selection signals received from the user input,

wherein at least one of the plurality of menus comprises the demultiplexed video, graphics and text, and wherein at least one of the plurality of menus comprises displaying a plurality of audio choices for accessing the audio; and

means for receiving the selection signals from the user input. (emphasis added).

In an exemplary embodiment of the present invention Applicant's invention provides a means such that a subscriber may separately access digital radio channels while other programming is being viewed on the television. (See e.g., Applicant's specification, p. 36, ll. 1-6.) A level D upgrade module may be used in conjunction with a set top terminal to provide the above features. (See *Id.*). Moreover, the digital radio channels may be accessed in a separate room from that of the television. (See *Id.*).

Applicant respectfully submits that Banker, Seth-Smith and Graczyk, alone or in any permissible combination, fail to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal, as positively recited by Applicant's independent claim 22.

Banker only teaches a method and apparatus for providing an on-screen user interface for a subscription television terminal. (See Banker, Abstract). Banker is silent to a feature of a set top terminal having a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television, the audio is

accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal.

In addition, Seth-Smith and Graczyk alone or in combination fail to bridge the substantial gap left by Banker. The Examiner responds to the Applicant's previous arguments asserting that there is no indication in Seth-Smith that the system would be limited to only one or the other as the Applicant suggests. The Applicant respectfully disagrees.

Seth-Smith teaches that two types of audio may be sent in the horizontal or vertical blanking intervals. One type of audio is the audio associated with the video and a second type of audio is a subscription audio. (See Seth-Smith, col. 7, ll. 58-68). The audio associated with the video clearly is not independent from the television signal.

The second type of audio is the subscription audio. Seth-Smith teaches that if the pay-per-listen bit is on, this means that a set of the audio channels are pay-per-listen channels. (See Seth-Smith, col. 27, ll. 54-57, emphasis added). In other words, the viewer must tune to a channel carrying the subscription audio. Moreover, Seth-Smith does not teach or suggest any picture in picture or multiple tuner embodiments that would allow a user to access two channels simultaneously.

In addition, as the Examiner states "Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output." (See Office Action dated February 22, 2008, p. 3, ll. 15-16, emphasis added). Thus, the Applicant respectfully submits that Seth-Smith is silent as to teaching or suggesting that the subscription audio is accessed simultaneously with the video since Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output.

Regardless, the Applicant further clarifies the claim to specify that the audio is accessed remotely from the set top terminal. This limitations is also absent from Seth-Smith as Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output.

In addition, Graczyk also fails to bridge the gap left by Banker and Seth-Smith because Graczyk also fails to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal,

the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal. Graczyk simply teaches a multipurpose computerized television. (See Graczyk, Abstract).

Consequently, even if Banker, Seth-Smith and Graczyk were permissibly combined, the combination would still fail to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal. As such, claim 22 is patentable over Banker in view of Seth-Smith and Graczyk.

Claim 23 recites relevant limitations similar to those recited in claim 22 and, accordingly, for at least the same reasons discussed above with respect to claim 22, claim 23 also is patentable over Banker in view of Seth-Smith and Graczyk. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 8-21

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Banker in view of Seth-Smith and U.S. Patent 5,539,871 to Gibson (hereinafter "Gibson") and Graczyk. Applicant respectfully traverses the rejection.

Claim 8 recites:

> 8. A set top terminal for generating an interactive electronic program guide for display on a television connected to the set top terminal, the terminal comprising:
>
> means for receiving a television signal;
>
> means for extracting individual programs from the television signal;
>
> means to demultiplex video, graphics and text;
>
> means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal;
>
> means for generating an electronic program guide for controlling display of content on a television screen, the guide comprising:
>
> a plurality of menus, wherein at least one of the menus comprises the demultiplexed video, graphics and text, and wherein at least one of the menus comprises displaying a plurality of audio choices

for accessing the audio;
a logo that is displayed on the television screen during one of the programs, which program has one or more interactive features; and
an overlay menu that is displayed during the one of the programs, the overlay menu including the interactive features; and
means for receiving selection signals from a user input,
wherein the logo indicates to a user that the interactive features are available for the program, and wherein the overlay menu is displayed in response to a signal received from the user input. (emphasis added).

In an exemplary embodiment of the present invention Applicant's invention provides a means such that a subscriber may separately access digital radio channels while other programming is being viewed on the television. (See e.g., Applicant's specification, p. 36, ll. 1-6.) A level D upgrade module may be used in conjunction with a set top terminal to provide the above features. (See *Id.*). Moreover, the digital radio channels may be accessed in a separate room from that of the television. (See *Id.*).

Applicant respectfully submits that Banker, Seth-Smith, Gibson and Graczyk, alone or in any permissible combination, fail to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal, as positively recited by Applicant's independent claim 8.

Banker only teaches a method and apparatus for providing an on-screen user interface for a subscription television terminal. (See Banker, Abstract). Banker is silent to a feature of a set top terminal having a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal.

Seth-Smith fails to bridge the substantial gap left by Banker. The Examiner responds to the Applicant's previous arguments asserting that there is no indication in Seth-Smith that the system would be limited to only one or the other as the Applicant suggests. The Applicant respectfully disagrees.

Seth-Smith teaches that two types of audio may be sent in the horizontal or vertical blanking intervals. One type of audio is the audio associated with the video and a second type of audio is a subscription audio. (See Seth-Smith, col. 7, ll. 58-68). The audio associated with the video clearly is not independent from the television signal.

The second type of audio is the subscription audio. Seth-Smith teaches that if the pay-per-listen bit is on, this means that a set of the audio channels are pay-per-listen channels. (See Seth-Smith, col. 27, ll. 54-57, emphasis added). In other words, the viewer must tune to a channel carrying the subscription audio. Moreover, Seth-Smith does not teach or suggest any picture in picture or multiple tuner embodiments that would allow a user to access two channels simultaneously.

In addition, as the Examiner states "Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output." (See Office Action dated February 22, 2008, p. 3, ll. 15-16, emphasis added). Thus, the Applicant respectfully submits that Seth-Smith is silent as to teaching or suggesting that the subscription audio is accessed simultaneously with the video since Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output.

Regardless, the Applicant further clarifies the claim to specify that the audio is accessed remotely from the set top terminal. This limitations is also absent from Seth-Smith as Seth-Smith never discloses any limitations on how the pay-per-listen channels would be output.

Moreover, Graczyk also fails to bridge the gap left by Seth-Smith and Banker because Graczyk also fails to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal. Graczyk simply teaches a multipurpose computerized television. (See Graczyk, Abstract).

In addition, Gibson fails to bridge the substantial gap left by Banker, Seth-Smith and Graczyk. Gibson only teaches a method and system for accessing associated data sets in a multimedia environment in a data processing system. (See Gibson, Abstract). Notably, Gibson is also silent as to teaching or suggesting a set top terminal having a

means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal.

Consequently, even if Banker, Seth-Smith, Gibson and Graczyk were permissibly combined, the combination would still fail to teach or suggest a means to receive an upgrade module that provides separate access to audio while a program extract from the television signal is being displayed, wherein the audio is independent from the television signal, the audio is accessed simultaneously while the television signal is being displayed and the audio is accessed remotely from said set top terminal. Thus, Banker, Seth-Smith, Gibson and Graczyk fail to teach or suggest Applicant's claimed invention as a whole. As such, Applicant's independent claim 8 is patentable under 35 U.S.C. §103(a) over Banker in view of Seth-Smith and Gibson and Graczyk.

Furthermore, claims 9-21 depend, directly or indirectly from independent claims 8 and 23, while adding additional elements. Therefore, claims 9-21 are also patentable over Banker in view of Seth-Smith and Gibson and Graczyk under 35 U.S.C. §103(a). Therefore, Applicant respectfully requests that the Examiner's rejection of claims 8-21, 24 and 25 under 35 U.S.C. §103(a) be withdrawn.

35 U.S.C. §103 Rejection of Claims 24 and 25

The Examiner has rejected claims 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over Banker, Seth-Smith and Graczyk, as applied to claim 23 above, and further in view of Gibson. Applicant respectfully traverses the rejection.

Each of the grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103 for the corresponding independent claims. Since the rejection of the corresponding independent claims under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office that any other additional references supply that which is missing from Banker, Seth-Smith and Graczyk to render the independent claims unpatentable, these grounds of rejection cannot be maintained. Therefore, Applicant

respectfully requests that the Examiner's rejection of claims 24 and 25 under U.S.C. §103(a) be withdrawn.

CONCLUSION

Thus, Applicant submits that all of the claims presently in the application are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 5/22/08

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